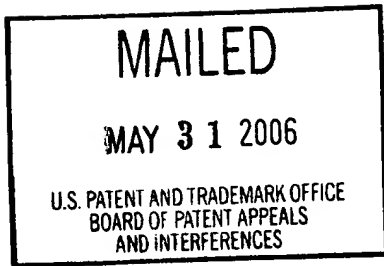


The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUSTIN LANGSETH, NICOLAS J. OROLIN,
AJAY TALWAR and PHILLIPPA J. FISHMAN



Appeal No. 2006-1069
Application No. 09/488,924

HEARD MAY 9, 2006

Before CRAWFORD, LEVY and NAPPI, Administrative **Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 27. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 27.

THE INVENTION

The invention relates to a system, which provides information to users. The information is stored in databases and organized into different channels, each with content about a specific interest, e.g. business information, weather

information, sports information. The system provides the information to users periodically through the day. Users subscribe to receive the information and can personalize the service they receive by selecting the information that suits their interest. See pages 5 through 7 of appellants' specification.

Claim 1 is representative of the invention and is reproduced below:

1. A system for delivering personalized informational content to subscribers comprising:
a personalized intelligence network system comprising:
subscription means for enabling users to subscribe to one or more services on one or more channel databases;
personalization means for enabling users to indicate personalization options relating to the one or more services;
one or more channel databases containing informational data about a subject matter of interest for a plurality of subscribers;
service processing means for processing at least one service for a plurality of subscribers using the information from one of the channel databases;
output forwarding means for automatically forwarding output from the services to one or more subscriber output devices specified for that service; and
revenue generating means for generating revenue as a result of the output of services to subscribers.

THE REFERENCE

The reference relied upon by the examiner is:

Harrington	5,895,454	April 20, 1999
		(Filed April 17, 1997)

THE REJECTION AT ISSUE

Claims 1 through 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Harrington. Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 27 under 35 U.S.C. § 103.

On pages 15 through 18 of the brief, appellants argue that Harrington fails to teach or make obvious, several of the limitations of the claims. Specifically, appellants focus on the claimed subscription means, a limitation to which the examiner has taken official notice of as being well known. Appellants argue that the office action fails to provide a motivation or suggestion to combine Harrington with the officially noticed facts. Appellants argue, on page 2 of reply brief, "[w]hat is fundamentally lacking in this analysis, however, is any indication in any of the art that lack of a user subscription in the Harrington system is a problem that needs to be solved, or why one would be motivated to modify the Harrington system to include a subscription feature."

On page 4 of the answer, the examiner responds:

The Examiner contends [sic] that a prima facie case has been established when combining Harrington and Examiner's Official notice of the ability of users to subscribe to services in order for the provider of the services the ability to gain income from the services they provide over time. There is a reasonable expectation of success that the services provided to users of the Harrington system could be provided for uses only after they subscribe so that the providers of this service can generate revenue. This has been commonly done on various websites such as ESPN so it is fair to believe there is a "reasonable expectation of success" in that it is possible to do. Finally the Examiner contends that the references when combined teach or suggest all of the claim limitations.

Further, the examiner reasons that since Harrington in column 5, lines 52+ discusses users registering for the services, it is reasonable to foresee that the user could subscribe to the services.

We disagree with the examiners rationale. Independent claim 1 recites a "subscription means for enabling users to subscribe to one or more services on one or more channel databases." Appellants' specification, on page 7, describes a subscriber as an individual or entity that receives a service on a given schedule. Thus, we construe the scope of the claim term "subscription" including the act of receiving service on a schedule. The Appellants' specification states on page 17 that subscribers may be charged for services. Further, Independent claim 1 recites a revenue generating means for generating revenue as a result of the output of services to subscribers. Thus, we do not find that the term "subscription" is limited to just receiving services in return for compensation.

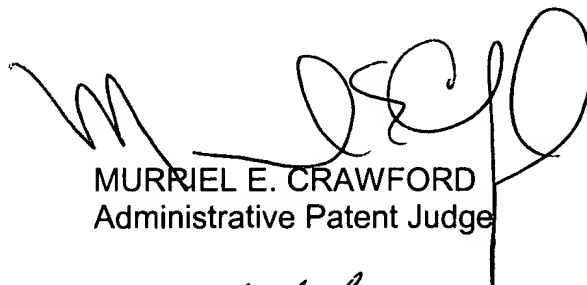
Harrington teaches an electronic shopping system. Users/shoppers can access a database of vendor information and query the database concerning product. The database returns, to the user/shopper, a selection of vendor web sites and allows the user to contact the vendor. See column 4, lines 8 through 22. The vendors subscribe and pay a fee to the system administrator in exchange for having information concerning their products in the database. See column 4, line 66 through column 5, line 21. Further, Harrington identifies that the user may fill out a registration page, and the information will be used in determining the selection of vendor web pages provided in response to the user query.

In rejecting claim 1, the examiner has equated the claimed user with Harrington's user/shopper. See page 2 of the final rejection dated May 29, 2003 and pages 4 through 6 of the Answer. The examiner has taken official notice that subscriptions are well known. We concur, and note that Harrington's system teaches that subscriptions are known for the vendors. However, this evidence does not lead us to conclude that it would have been obvious for users of Harrington's system to subscribe, as asserted by the examiner. Harrington teaches that the shopping system's administrator receives compensation from advertising and fees paid by the vendors not the users. See column 5, line 9 through 13. Thus, we do not find Harrington has the need to generate revenue from subscriptions as asserted by the examiner. Accordingly, we do not find that the evidence provided by the examiner teaches or suggests a subscription means as recited in claim 1.

We note that the examiner has further asserted that subscription means to access databases has been known and used by websites such as ESPN. See Answer page 4. However, the examiner has provided no objective evidence to prove such an assertion, nor has the examiner rejected the claims based upon such evidence. Should the examiner consider the claims to be unpatentable over websites such as ESPN, the examiner should make a rejection and provide evidence to support a finding of unpatentability over such websites.

In summary we will not sustain the examiner's rejection of claims 1 through 27 under 35 U.S.C. § 103. The decision of the examiner is reversed.

REVERSED



MURRIEL E. CRAWFORD
Administrative Patent Judge



STUART S. LEVY
Administrative Patent Judge



ROBERT E. NAPPI
Administrative Patent Judge

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